

Remarks

Reconsideration of the present application is respectfully requested.

New claim 25 is added.

The rejection of claim 2 under 35 USC 112, first paragraph, is respectfully traversed.

Claim 2 is rejected on the basis that the recitation "deriving a sector number from the bit-groups and not from the digital remainder portions" fails to comply with the enablement requirement, and that the recitation is not clear and does not accord with what was disclosed in the specification.

Enablement is a question of whether the experimentation required by a skilled artisan to practice the invention would be undue or unreasonable. *Mineral Separation, Limited, et al. v. Hyde*, 242 U.S. 261, 270 (1916). However, the Written Opinion has not pointed out how the recitation at issue would have required undue experimentation on the part of a skilled artisan.

In any event, it is respectfully submitted the recitation at issue is clear and is in accord with what is disclosed in the specification. For example, the specification at page 9, lines 23 to 31, clearly describes, with the aid of a flowchart in Fig. 5, a step in which "several servo fields are then read from the data surface, each servo field consisting of a digital portion and an analog portion, each digital portion consisting of a set label and a remainder portion 530." Making reference to Fig. 6, the specification at page 10, lines 25 to 28 further explains that "the digital portion 632 of servo sector 621 includes a bit-group 633 for indicating sector number (i.e. a circumferential location) and additional bits 634 for indicating cylinder number (i.e. a radial location)". In addition, an example is given at page 10, line 31, to page 11, line 2, in which "it can be seen that digital portion 632 consists of 20 bits in this example. Two of the bits 640, 641 (for M=2) comprise bit-groups 633, and the remaining 18 bits 650 through 667 contain the cylinder number." For further illumination, the skilled artisan may also refer to Figs. 5 to 8, which illustrate associated configurations and methods. In view of the various exemplary methods and apparatus that have been clearly set forth in the specification, there is no cause for undue experimentation by a skilled artisan when implementing the invention.

Claim 2 therefore meets the requirements of 35 USC 112, first paragraph.

The rejection of claim 1 under 35 USC 102(b) as being anticipated by Greenberg, et al. (US 6,104,558) is respectfully traversed.

Column 7, lines 29 to 32 of Greenberg reads "several important aspects of the present invention are illustrated in reference to Table II. First, the encoded servo address changes for each sector in a track" (emphasis added). Thus, Greenberg does not expressly disclose and cannot inherently disclose "consecutively-placed identical bit-groups". Claim 1 of the present application, however, includes "consecutively-placed identical bit-groups". Clearly, Greenberg fails to identically or inherently describe every element of claim 1.

Accordingly, it is submitted that claim 1, as well as dependent claims 3-5, 10, and 13, is not anticipated by Greenberg. It is also submitted that corresponding apparatus claims 15, 18, 21, and 22 are similarly not anticipated by Greenberg. It is further believed that the new apparatus claim 25, which corresponds to method claim 1, is allowable on similar grounds.

Claim 12 is rejected under 35 USC 103(a) as being unpatentable over Greenberg in view of Ramler et al. (US 2003/0161067A1), on the belief that Greenberg discloses the method of claim 1.

Not only does Greenberg fail to disclose every element of claim 1, it clearly teaches away from claim 1, as evident from Greenberg's description at col. 7, lines 29-32, quoted above. Since claim 12 depends from claim 1, it follows that not all elements of claim 12 have been taught or suggested by the references cited.

Therefore, it is respectfully submitted that a *prima facie* case of obviousness has not been established and that claim 12 is allowable.

The indication that claims 6-9, 11, 16-17, 19-20, and 23-24 are allowable is noted with thanks. It is believed that their base claims and any intervening claims are also allowable, and thus these claims have not been rewritten in independent form.

Conclusion

This Reply is believed to be responsive to all points raised in the Office Action. Accordingly, prompt allowance and passage of the application to issue are earnestly solicited. Should the Examiner have any remaining questions or concerns, he/she is encouraged to contact the undersigned attorney by telephone to expeditiously resolve such concerns.

Respectfully submitted,

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(Assignee of the Entire Interest)

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Date

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